

May 05 05 12:56p

SVIPG

408 971 4660



ZILKA KOTAB

PC
ZILKA, KOTAB & FEECE™

55 SOUTH MARKET ST., SUITE 420
SAN JOSE, CA 95113

TELEPHONE (408) 971-2573
FAX (408) 971-4660

RECEIVED
CENTRAL FAX CENTER

MAY 05 2005

FAX COVER SHEET

Date: May 5, 2005	Phone Number	Fax Number
To: Petitions Division, USPTO		(703) 872-9306
From: Dominic M. Kotab		

Docket No.: HIT1P020A/SJ0920010068US2

App. No: 10/601,021

Total Number of Pages Being Transmitted, Including Cover Sheet: 12

Message:

Please deliver to the Petitions Division.

Thank you,

Dominic M. Kotab

RECEIVED

MAY 20 2005

OFFICE OF PETITIONS

☐ Original to follow Via Regular Mail ☒ Original will Not be Sent ☐ Original will follow Via Overnight Courier

The information contained in this facsimile message is attorney privileged and confidential information intended only for the use of the individual or entity named above. If the reader of this message is not the intended recipient, you are hereby notified that any dissemination, distribution or copy of this communication is strictly prohibited. If you have received this communication in error, please immediately notify us by telephone (if long distance, please call collect) and return the original message to us at the above address via the U.S. Postal Service. Thank you.

IF YOU DO NOT RECEIVE ALL PAGES OR IF YOU ENCOUNTER
ANY OTHER DIFFICULTY, PLEASE PHONE Erica
AT (408) 971-2573 AT YOUR EARLIEST CONVENIENCE

May 5, 2005

RECEIVED
OIP/PTAP

JUL 14 2005

BEST AVAILABLE COPY

BEST AVAILABLE COPY



Attorney's Docket No. HIT1P020A/SJ0920010068US2

MAY 15 PM 4:06

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Douglas Werner
 Application No.: 10/601,021
 Filed: 06/19/2003
 For: PLANAR GAP PRE-FILL METHOD FOR READ HEADS

Group No.: 3729
 Examiner: Kim, Paul D.

RECEIVED

MAY 20 2005

Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

OFFICE OF PETITIONS

PETITION TO WITHDRAW HOLDING OF ABANDONMENT
 — OFFICE ACTION NOT RECEIVED

1. I hereby petition to withdraw the holding of abandonment in this case, on the basis that the Office Action forming the basis of the abandonment was not received.
2. I hereby state:
 - (a) The Office Action indicated, as mailed on August 26, 2004, was not received.
 - (b) A search of the file jacket and the docket records in my office indicates that this Office Action was not received.
 - (c) The PAIR site indicates that the Office Action was returned to the USPTO as undeliverable on August 26, 2004.

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10*
 (When using Express Mail, the Express Mail label number is mandatory;
 Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

MAILING

deposited with the United States Postal Service in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

37 C.F.R. § 1.8(a)

with sufficient postage as first class mail.

37 C.F.R. § 1.10*

as "Express Mail Post Office to Addressee"

Mailing Label No. (mandatory)

TRANSMISSION

✓ facsimile transmitted to the Patent and Trademark Office, (703) 872-9306.

Erica L. Farlow
 Signature

Date: 5/5/2005

Erica L. Farlow

(type or print name of person certifying)

* Only the date of filing (1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under 1.8 continues to be taken into account in determining timeliness. See 1.703(f). Consider "Express Mail Post Office to Addressee" (1.10) or facsimile transmission (1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

Petition to Withdraw Holding of Abandonment—Office Action Not Received—page 1 of 2

05/19/2005 DILLEN 00000001 502587 10601021

01 FC:1464 130.00 DA

3. I attach a copy of the docket record where the non-received Office Action would have been entered had it been received and docketed. Please see page 2 of Exhibit A. This shows how the entry would have appeared on our docket.

4. As additional evidence of non-receipt of the Office Action, I also attach:

Exhibit B is a copy of the PAIRConnect Patent Record which shows a direct comparison of the PTO Action Items on the PAIR system and the IP Master Actions listed in our docketing database. The PAIR column shows the mailing of the Non-Final Rejection on 8/26/2004, but there is no action noted as received on our side.

Exhibit C is a copy of the PAIR Image File Wrapper showing the Non-Final Rejection was returned to the USPTO as undelivered on 08/26/2004. Please note that is the same date as the Mailing date of the Action.

Exhibit D is a copy of our Firm's Audit Sheet showing a note from docketing department personnel highlighting the non-receipt of the Office Action in question.

5. In consideration of these submissions, it is respectfully requested that the holding of abandonment be withdrawn.

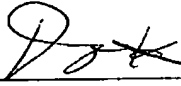
6. The petition fee (37 C.F.R. § 1.17(h)—\$130.00) is paid as follows:

Should the Commissioner find that a fee is necessary, authorization is hereby made to charge the amount of \$130.00 to Deposit Account No. 50-2587 (Order No. SJ0920010068US2).

Charge any additional fees required by this paper or credit any overpayment in the manner authorized above.

A duplicate of this paper is attached.

Reg. No.: 42,762
Tel. No.: 408-971-2573
Customer No.: 50535



Signature of Practitioner
Dominic M. Kotab
Zilka-Kotab, PC
P.O. Box 721120
San Jose, CA 95172-1120
USA

Patent Case Print [ID 1064]

Page 1 of 2

Exhibit A

COPY



Patent: HIT1P020A, United States, Regular, National,
Division

Patent Data

Docket No.	HIT1P020A	Senior Attorney	Dominic M. Kotab
Country	United States	Primary Attorney	
Case Type	Regular	Client/Division	Hitachi Global Storage Technologies, Inc.
Relation Type	Division	Current Owner	Hitachi Global Storage Technologies, Inc.
Filing Type	National	Previous Owner	
Filing Number		Client Case No.	SJ09-2001-0068US2
Status	Filed	First Filing Date	6/5/2001
Sub Status		Sub Status Date	
Parent Country	United States	Parent Filing Date	6/5/2001
Parent Number	09/875,405	Parent Grant Date	
Application Number	10/601,021	Application Date	6/19/2003
Patent Number		Grant Date	
Publication Number	2004-0085680	Publication Date	5/6/2004
Assigned	Assignment Made	Ind. Claims/Designs	
Convention Type	Based on Priority Case	Total Claims	
Req Not To Pub Incl	No	Total Classes	
TaxAgent		Confirmation Number	
Firm Attorney		Tax Base Date	
Administrator		Next Tax Date	
Custom Party #2		Expiration Date	
Custom Party #3		Custom Text #1	
Custom Party #4		Custom Date #1	
Custom Party #5		Alt Case No	
Custom Party #6		Priority Date	6/5/2001
Custom Party #7		US Case No	09/875,405
Custom Party #8		Custom Date #3	
Firm Case Number		Custom Text #4	
Custom Code #2		Custom Date #4	
Custom Code #3		Text #5	
Custom Code #4		Text #6	
Custom Code #5		Text #7	
Custom Code #6		Text #8	
Custom Code #7		Confirm No	
Customer Code	00PP	Customer Name	Silicon Valley IP Group

Title

Planar Gap Pre-Fill Method For Read Heads

Description

Current Expense Information

Other Case-Related Information

Actions

Action Code	Action Due Date	Taken Date	Deadline Date	Completed Date	Post Card Received	Who	Action Notes
Information Disclosure Statement	8/1/2004			7/29/2004		Dominic M. Kotab	

file://C:\Program Files\IPMaster\ipmPatent1064.htm

4/20/2005

Patent Case Print [ID 1064]

Page 2 of 2

Revised publication date	5/6/2004	5/6/2004	Dominic M. Kotab
Priority Doc. To Be Filed	10/19/2003	10/19/2003	Dominic M. Kotab
Filing Postcard	7/19/2003	6/19/2003	Dominic M. Kotab
Filing Receipt	8/19/2003	9/16/2003	Dominic M. Kotab
No Foreign Filing	6/19/2004	6/19/2004	Dominic M. Kotab
Foreign filing - 11 month remi	5/19/2004	6/19/2004	Dominic M. Kotab
Recorded Assignment Received	8/19/2003		Dominic M. Kotab
Preliminary Amendment		6/19/2003	Dominic M. Kotab
Status Inquiry	6/19/2005		Dominic M. Kotab
Reminder	8/1/2004	7/29/2004	Dominic M. Kotab
Check PAIR	8/29/2004	8/11/2004	Dominic M. Kotab
File Audit Date		4/11/2005	
Notes		4/11/2005	
			During the file audit, PAIR shows that a non-final rejection was mailed on 8/26/2004, but we never received it. The file was given to Dominic who said he'd follow up with the examiner.
Follow up	4/18/2005		Dominic M. Kotab
			Regarding the non-final rejection that PAIR says was mailed 8/26/2004 that we never received
Follow up	4/25/2005		Dominic M. Kotab
			Regarding the non-final rejection that PAIR says was mailed 8/26/2004 that we never received
Office Action Mailed Date		8/26/2004	Dominic M. Kotab
Office Action 3 mos.	11/26/2004		Dominic M. Kotab
Office Action 6 mos.	2/26/2005		Dominic M. Kotab

entered 4/11/05 during file audit

Inventors

Inventor	Custom Text #2	Assignment Date	Inventor Date #2	Inventor 1	Inventor 2	Real Number 1	Real Number 2
Douglas Werner		5/31/2001					

CreateUser: dbo

UpdateUser: Melissa

CreateDate: 6/23/2003

UpdateDate: 4/11/2005

Copyright 2002 by Master Data Center, Inc.

HIT1P020A

IP MASTER

Case Type: Regular
 Relationship: Division
 Filing Type: National
 Filing #: 10601021
 Application Publication: 2004-0085680
 Patent: 5/6/2004
 Expiration Date: 6/19/2003
 Filed: 5/6/2004

Domestic M. Kotab
 Hitachi Global Storage Technologies, Inc.
 Hitachi Global Storage Technologies, Inc.

Number: 10601021
 Date: 6/19/2003
 Filed: 5/6/2004

Planar Gap Pre-Fill Method For Read Heads

PAIRConnect Patent Record

Exhibit B

PAIR

PAIR

ADJ

EST

Downloaded 4/20/2005 10:45:00 AM

Attorney Docket No.: HIT1P020A/SIO9-2001
 Confirmation Number: 7090
 Customer Number: 50535

Pre Issue Petition:
 Post Issue Pet:
 PTO Adjustment:
 PTO Delay:
 Three Year Delay:
 Applicant Delay:
 Total PTA:

Application Publication Patent: 10601021
 Number: 2004-0085680
 Date: 6/19/2003
 Filed: 5/6/2004

Status: Non Final Action Mailed
 ClassSub: 029/603.13
 Examiner: KIM, PAUL D
 Location: ELECTRONIC

7
 0
 7

Exhibit B

IP Master Actions

PAIR Actions

PAIR
 ADJUSTED
 ESTIMATED
 Corrected
 Date

Notes	Date	PAIR Actions	PTO	APP	PTO	APP	PTO	APP	Corrected Date
File Audit Date	4/11/2005								
3/7/2005		Correspondence Address Change							
10/24/2004		Correspondence Address Change							
8/26/2004		Mail Non-Final Rejection							
8/24/2004		Non-Final Rejection							
8/11/2004		Reference capture on IDS							
8/11/2004		Information Disclosure Statement (IDS) Filed							
8/11/2004		Case Docketed to Examiner in GAU							
7/29/2004		Reminder							
7/29/2004		Information Disclosure Statement							
6/19/2004		No Foreign Filing							
6/19/2004		Foreign filing - 11 month rentl							
6/6/2004		Revised publication date							
3/4/2004		IPW TSS Processing by Tech Center Complete							
3/3/2004		Case Docketed to Examiner in GAU							
10/19/2003		Application Is Now Complete							
9/16/2003		Pre-Exam Office Action Withdrawn							
9/15/2003		Application Return TO OIPE							
9/15/2003		Application Return from OIPE							
9/15/2003		Application Is Now Complete							
9/15/2003		Application Dispatched from OIPE							

HIT1P020A

PAIRConnect Patent Record

Downloaded 4/20/2005 10:45:00 AM

8/26/2003

Cleared by OIPE CSR

7/12/2003

IFW Scan & PACR Auto Security Review

6/18/2003

Initial Exam Team nn

Preliminary Amendment

6/19/2003

Filing Postcard 6/19/2003

[illegible]

PAIR:

Page 1 of 2

Exhibit C

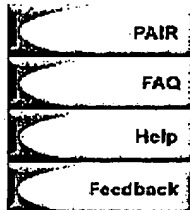
COPY



United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [FAQ](#) | [Glossary](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)

PATENT APPLICATION INFORMATION RETRIEVAL



Other Links

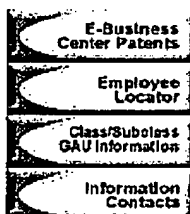


Image File Wrapper for Application No.: 10/601,021

NET

This application is officially maintained in electronic form. To View: Click the desired Document Description and click Download.

Mail Room Date	Document Description	Document Category
12/21/2004	Change of Address	PROSECUTION
08/26/2004	Bibliographic Data Sheet	PROSECUTION
08/26/2004	Mail returned to USPTO as undelivered	PROSECUTION
08/26/2004	Non-Final Rejection	PROSECUTION
08/26/2004	List of references cited by examiner	PROSECUTION
08/26/2004	Foreign Reference	PROSECUTION
08/26/2004	NPL Documents	PROSECUTION
08/26/2004	Search information including classification, databases and other search related notes	PROSECUTION
08/26/2004	Index of Claims	PROSECUTION
08/24/2004	Examiner's search strategy and results	PROSECUTION
08/11/2004	Information Disclosure Statement (IDS) Filed	PROSECUTION
08/11/2004	Foreign Reference	PRIOR ART
06/19/2003	Oath or Declaration filed	PROSECUTION
06/19/2003	Fee Worksheet (PTO-875)	PROSECUTION
06/19/2003	Claims Worksheet (PTO-2022)	PROSECUTION
06/19/2003	Transmittal letter	PROSECUTION
06/19/2003	Preliminary Amendment	PROSECUTION
06/19/2003	Specification	PROSECUTION
06/19/2003	Claims	PROSECUTION
06/19/2003	Applicant Arguments or Remarks Made in an Amendment	PROSECUTION
06/19/2003	Specification	PROSECUTION
06/19/2003	Claims	PROSECUTION
06/19/2003	Abstract	PROSECUTION

PAIR:

Page 2 of 2

06/19/2003	Drawings	PROSECUTION
06/19/2003	Fee Worksheet (PTO-875)	PROSECUTION

Sorted By : Mail Room Date

[HOME](#) | [INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [CONTACT US](#) | [PRIVACY STATEMENT](#)

Exhibit D

US Patent Applications

COPY

April

2005 File Audit

Docket Number HIT1P020A/ Application Number 10/601,021Filing Date SI09-2001-0068US2Match in Docket, FR, Express Mail
Receipt and Postcard?yes, 6/19/03Foreign FilingForeign Filing Date Docketed
Priority DateNO
2/10Rescind Non-Publication Request45 Days after FF docketed (after 11/29/00)
Date RescindedN/A
2Small Entity StatusSmall Entity Status Claimed?
Loss of Entitlement Filed?NO
N/AAssignmentVerify Correct Assignee
Verify Recordationyes - ok on assignments submit
has not been recorded yetPetition to Make Special

6 & 9 month follow-ups docketed?

NO N/AStatus Check

Status OA docketed (2 yrs. from filing date)

yes, 6/19/05IDSfiled 7/29/04PAIR VerificationDate/Type of Last Action Sent
Verification of Receipt of Last Action7/29/04 IDS filed
yes

* Notes: PAIR shows that a non-final rejection was mailed to us 8/26/04, but we never received it.

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☒ **BLACK BORDERS**
- ☐ **IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- ☐ **FADED TEXT OR DRAWING**
- ☐ **BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- ☐ **SKEWED/SLANTED IMAGES**
- ☐ **COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- ☐ **GRAY SCALE DOCUMENTS**
- ☐ **LINES OR MARKS ON ORIGINAL DOCUMENT**
- ☐ **REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- ☐ **OTHER:** _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.